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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,736	04/09/2004	Hisashi Takeuchi	MM4719	1520
7590 12/29/2005 Anderson Kill & Olick, P.C. 1251 Avenue of the Americas New York, NY 10020-1182			EXAMINER BEAUCHAINE, MARK J	
			ART UNIT 3653	PAPER NUMBER
DATE MAILED: 12/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/821,736

Applicant(s)

TAKEUCHI ET AL.

Examiner

Mark J. Beauchaine

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/28/05 & 6/24/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the terms "identified them" in lieu of "identifying them" in line 11, and "notes but the rejected" in lieu of "notes but not the rejected" in lines 14 and 15. Said terms are ambiguous.

Claim 1 recites the limitation "previous stage" in lines 17 and 18, and claim 6 recites the term "user identification unit" in line 6 ("user recognition unit"?). There are insufficient antecedent bases for these limitations in the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication Number 2004/0084521 A1 by Nagayoshi et al (hereinafter Nagayoshi) published 6 May 2004.

The automatic teller machine (ATM) disclosed in Nagayoshi incorporates cash in/out unit 101, bill validator 103, temporary stacker 101 and cash in/out unit that reads on the Applicant's inlet and dispensing units, identifying unit, temporary money holder and rejection unit, respectively. Furthermore, said ATM incorporates cash box 121, unclassified box 122 and counterfeit cash box 124 that read on the Applicant's storage cells. Still further, Nagayoshi discloses a "USER ID" within display 202 (see Figure 6) that reads on the Applicant's user recognition unit. Regarding claim 5, said ATM further incorporates main memory 131 that reads on the Applicant's memory.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagayoshi as applied to claim 1 above, and further in view of Patent Number US

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6,363,164 B1 by Jones et al (hereinafter Jones). Although Nagayoshi fails to specifically disclose a currency identifying unit of Applicant's claim 4 that includes a sensor reader, the use of such a reader is well known in the art. Jones teaches a currency processing machine that accepts banknotes and identifies specific serial numbers of said notes via authentication unit 14 (column 6, lines 13 plus). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the authentication unit 14 of Jones into the ATM apparatus of Nagayoshi to provide an effective means of identifying individual banknotes.

Regarding claims 7 and 8, said currency process machine of Jones further incorporates interface 24 that reads on the Applicants communication unit. Said interface 24 provides communication between said ATM and various remote computer systems. It would have been obvious to one of ordinary skill to incorporate the computer interface configuration of Jones to provide an effective means of network communication.

### ***Information Disclosure Statement***

Two foreign documents listed in information disclosure statement filed on 28 March 2005 fails to comply with 37 CFR 1.98(a)(2), because no English language copy was found in the record of file. Said documents have not been considered.

### ***Inventorship***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Drawings***

A new copy of page 3 of 9 of the drawings is required because the scanned computer image of said page was partially obliterated and thus unreadable. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Patent Number 6,000,555 by Anna because of its currency containers 50, 51  
and 52,

Patent Number 5,909,814 by Arikawa because of its bill discrimination section 5,  
and

Patent Number 5,135,212 by Utsumi et al because of its money port 7.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Mark J. Beauchaine whose telephone number is  
(571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM  
Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Donald P. Walsh can be reached on (571)272-6944. The fax phone number  
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the  
Patent Application Information Retrieval (PAIR) system. Status information for  
published applications may be obtained from either Private PAIR or Public PAIR.  
Status information for unpublished applications is available through Private PAIR only.  
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

mjb



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